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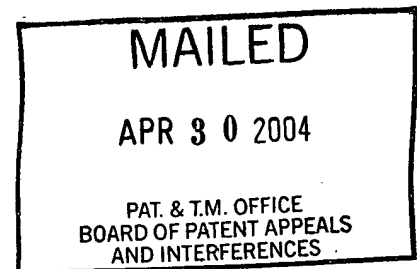
BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

JOHN L. SERNYK and JUAN E. ROMERO LANUZA  
Junior Party  
(Patent 5,965,755),

v.

LORIN R. DEBONTE  
Senior Party  
(Application 10/034,698).

Patent Interference No. 105,163



Before: SCHAFER, TORCZON and POTEATE, Administrative Patent Judges.

POTEATE, Administrative Patent Judge.

**JUDGMENT—RULE 662**

**Part A. Conference call**

A telephone conference call was held in this interference on April 24, 2004, at approximately 10:00 a.m. (EST), including:

1. Linda R. Poteate, Administrative Patent Judge;
2. Oliver R. Ashe, Jr., Esq., counsel for Sernyk; and
3. Eugene C. Rzucidlo, Esq., counsel for DeBonte.

### **Part B. Relevant discussion during conference call**

The conference call was initiated by counsel for DeBonte for the purpose of discussing DeBonte's Request for Entry of Judgment against DeBonte. Adverse judgment is requested on the basis that DeBonte's involved claims (claims 20-72) are not patentable to DeBonte under 35 U.S.C. § 135(b) (Paper 52). DeBonte's request for entry of adverse judgment is an abandonment of the contest as to the counts. 37 CFR 1.662(a). It is appropriate, therefore, to enter adverse judgment against DeBonte.

During the conference call, the Order relating to Sernyk's requests for discovery/testimony (Paper 41) was discussed and it was noted that DeBonte's/Cargill's answers to Sernyk's discovery requests are due on April 30, 2004 and that the deposition of Willie H.T. Loh is scheduled to take place next month. Sernyk asks that entry of adverse judgment be deferred until after discovery is complete. In light of DeBonte's abandonment of the contest, we see no reason to continue discovery into matters related to the issues raised in this interference.

### **Part C. Order**




Upon consideration of DeBonte's Request for Entry of Judgment and Sernyk's Response thereto (Paper 53) and in view of the above, it is hereby:

**ORDERED** that senior party Lorin R. DeBonte is not entitled to a patent containing claims 20-72 of Application 10/034,698.

**FURTHER ORDERED** that the Order directing DeBonte and Cargill to respond to Sernyk's discovery requests and authorizing Sernyk to take the testimony of Willie H.T. Loh (Paper 41), is vacated.

**FURTHER ORDERED** that a copy of this paper and Paper 51 shall be made of record in the files of application 10/034,698 and U.S. Patent 5,965,755.

**FURTHER ORDERED** that if there is a settlement agreement, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661.

  
RICHARD E. SCHAFER  
Administrative Patent Judge  
  
RICHARD TORCZON  
Administrative Patent Judge  
  
LINDA R. POTEATE  
Administrative Patent Judge

BOARD OF PATENT  
APPEALS AND  
INTERFERENCES

INTERFERENCE  
TRIAL SECTION

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Przybylski & Bruce E. McDonald eds., AOCS Press 1995) by W.A. Keller, IMC 01 is indicated as having 61.9% oleic acid, 23.9% linoleic acid, 4.9%  $\alpha$ -linolenic acid (SX 2005, p. 89). The source of the data is said to be W.H.T. Loh of Cargill, Inc.

In Table X of the DeBonte '279 specification, IMC 01 is indicated as having 63.5% oleic acid, 22.2% linoleic acid, 4.9%  $\alpha$ -linolenic acid (SX 2018, p. 28).

## 2. Specifications

The background section of the DeBonte '279 and '698 Applications includes the following statements:

There remains a need for an improved canola seed and oil with very low  $\alpha$ -linolenic levels in the oil and low glucosinolates in the seed to significantly reduce the need for hydrogenation. The  $\alpha$ -linolenic content of such a desirable oil would impart increased oxidative stability.

(SX 2007, p. 4, ll. 24-29).

[The] invention comprises a *Brassica napus* canola yielding seed having a total glucosinolates content of about 18  $\mu\text{mol/g}$  or less of defatted, air-dried meal; the seed yielding extractable oil having 1) an  $\alpha$ -linolenic acid content of about 7% or less relative to total fatty acid content of the seed, and 2) a very low sulfur content of less than or equal to 3.00 ppm.

(SX 2007, p. 5, ll. 6-12).

[The] invention further comprises a seed designated IMC 01 deposited with the American Type Culture Collection, 12301 Parklawn Drive, Rockville, MD, USA 20852 and bearing accession number ATCC 40579, the progeny of such seed and oil of such a seed possessing the quality traits of interest.

(SX 2007, p. 6, ll. 1-6).

### 3. Claims

The DeBonte '279 Application claims do not include an explicit recitation of oleic acid or linoleic acid content.<sup>3</sup>

Claims containing explicit language relating to oleic acid and linoleic acid content were first presented in the DeBonte '698 Application in a preliminary amendment filed December 27, 2001 (SX 2027). This date is more than one year after issuance of the Sernyk '755 Patent.

The December 27, 2001 preliminary amendment cancelled claims 1-19 in favor of new claims 20-55.

A Notice of Allowance was mailed on June 17, 2002 (DeBonte '698 File wrapper, Paper 6).

In the Examiner's Reasons for Allowance set forth in the Notice of Allowability, the examiner stated:

The instant invention consisting of a canola oil containing an oleic acid content in the range of 66.3% to 72.6% and an alpha-linolenic acid content of less than about 7% is considered to be unobvious and unanticipated over the prior art of record. The closest prior U.S. Pat. 5,387,758 teaches a canola oil containing an oleic acid content reading on the instant range.

However it is not taught or suggested by US Pat. 5,387,758 that the oil would contain an alpha-linolenic acid content less than about 7% in conjunction with the oleic acid content.

(SX 2033, page 2, ¶¶ 1-2).

DeBonte did not file Comments on the Examiner's Statement of Reasons for Allowance.

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<sup>3</sup>Representative claims from the DeBonte '279 Application are reproduced in the Appendix. *See, infra*, p. 12.

A Request for Continued Examination was filed in the DeBonte '698 Application on September 17, 2002 (DeBonte '698 File wrapper, Paper 7). A preliminary amendment was also filed adding new claim 56.

Claims containing an explicit recitation of oleic acid/linolenic acid and (oleic acid + linoleic acid)/ $\alpha$ -linolenic acid ratios, and combined linoleic acid +  $\alpha$ -linolenic acid content were first presented in the DeBonte '698 Application in a preliminary amendment filed April 23, 2003 (SX 2036).

The April 23, 2003 amendment added new claims 57-72.

DeBonte provoked the present interference by filing a Request for Interference under 37 CFR § 1.607 on August 19, 2003 (SX 2016).

In the Request for Interference, DeBonte stated that the requirements of 35 USC § 135(b) were met because (1) claims relating to the same subject matter were present in the DeBonte '279 application and (2) claims corresponding to the proposed count were presented in Application 09/304,366<sup>4</sup> (SX 2016, page 2).

#### **G. Initial Conference Call**

On January 16, 2004, a conference call was held for the purpose of setting times for taking action during the preliminary motions phase of the interference (Paper 17, page 1).

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<sup>4</sup>Application 09/304,366, filed May 4, 1999, now U.S. Patent 6,201,145, issued March 13, 2001 to Zhegong Fan (SX 2032) is the parent of Application 10/273,518, filed on October 18, 2002. Application 10/273,518 is involved in related Interference No. 105,162.

During the conference call, and in a list of proposed preliminary motions filed prior to the conference call (Paper 16), Sernyk sought leave to file a preliminary motion to establish unpatentability of DeBonte's claims under 35 USC § 135(b).

Sernyk was authorized to file this preliminary motion on an expedited basis.<sup>5</sup>

### III. Discussion

To provoke an interference, an applicant must have patentable claims in the application which are (1) clearly supported by the specification (37 CFR § 1.75(d)(1) (July 2003)) and (2) are directed to the "same patentable invention" as claimed by the patentee (37 CFR § 1.601(i) & (n)<sup>6</sup> (2003)). However, "[a] claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted."

35 USC § 135(b).

Sernyk asserts that the involved DeBonte '698 Application claims are unpatentable to DeBonte under 35 USC § 135(b) because DeBonte did not claim the same or substantially the same invention defined by the Sernyk '755 Patent claims within one year (i.e., October 12, 2000)

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<sup>5</sup>"An administrative patent judge may take up motions for decisions in any order, may grant, deny, or dismiss any motion, and may take such other action which will secure the just, speedy, and inexpensive determination of the interference." 37 CFR § 1.640(b) (2003). See *Berman v. Housey*, 291 F.3d 1345, 1351, 63 USPQ2d 1023, 1027 (Fed. Cir. 2002) ("The absence of an interfering claim that is not barred under § 135(b) therefore renders an interference nonexistent, and thus deprives the Board of its authority to continue the proceeding.")

<sup>6</sup>"Invention 'A' is the *same patentable invention* as an invention 'B' when invention 'A' is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention 'B' assuming invention 'B' is prior art with respect to invention 'A'."



of the issuance of the Sernyk '755 Patent.<sup>7</sup> There is no dispute that the involved DeBonte '698 Application claims are directed to the same or substantially the same invention as the Sernyk '755 Patent claims.<sup>8</sup> There is also no dispute that DeBonte's '698 Application claims *were not made within one year* of the grant of the Sernyk '755 Patent. However, DeBonte argues that the one year requirement of 35 USC § 135(b) have been met because the parent DeBonte '279 Application claims were pending prior to October 12, 2000.

Sernyk argues that the DeBonte '279 patent claims are not directed to "the same or substantially the same" oil as recited in the Sernyk '755 Patent claims because the '279 application and/or prosecution files did not include any claims directed to oils having (1) a specified oleic acid/linolenic acid ratio, (2) a specified (oleic acid + linoleic acid)/linolenic acid ratio and a (3) specified linoleic+linolenic acid content (Sernyk Preliminary Motion 1, Paper 24, p. 17). DeBonte maintains that the DeBonte '279 Application claims inherently included these features (DeBonte Opposition 1, Paper 39, p. 17). In particular, DeBonte relies on DeBonte '279 Application claims which encompass a low linolenic canola oil from the seeds of *Brassica*

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<sup>7</sup>"A party filing a motion has the burden of proof to show that it is entitled to the relief sought in the motion." 37 CFR § 1.637(a) (2003).

<sup>8</sup>Sernyk does not dispute that a canola oil containing 72.6% oleic acid, 14.4% linoleic acid and 2.0%  $\alpha$ -linolenic acid has oleic acid/linolenic acid and (oleic acid + linoleic acid)/linolenic acid ratios which fall within the scope of the '755 patent claim (*see* Sernyk Reply 1, Paper 42, p. 3 (admitting DF 17 and 18)). *See In re Tanke*, 213 F.2d 551, 555, 102 USPQ 83, 85 (CCPA 1954) (Where it is determined that subject matter of differently claimed inventions is directed to substantially the same invention, the specific variations in the claims are a mere distinction in breadth or scope within the same or substantially the same subject matter. The claims do not define separate inventions or inventions which are not substantially the same.)

plants (*id.*, pp. 9-10).<sup>9</sup>

In determining compliance with 35 USC § 135(b), it is first necessary to determine whether a limitation of a patent claim is material and, if so, whether the limitation is claimed by the applicant, expressly or inherently. *In re Berger*, 279 F.3d 975, 983, 61 USPQ2d 1523, 1528 (Fed. Cir. 2002); *In re Schutte*, 244 F.2d 323, 326, 113 USPQ 537, 540 (CCPA 1957).

"[S]ection 135(b) was enacted to codify a legal principle akin to laches, imposing a statute of limitations, so to speak, on interferences so that the patentee might be more secure in his property right." *In re Berger*, 279 F.3d at 982, 61 USPQ2d at 1527 (quoting *Corbett v. Chisholm*, 568 F.2d 759, 764-65, 196 USPQ 337, 342 (CCPA 1977)). To further that purpose, later-filed claims may be entitled to the earlier effective date of prior claims in an application if the material limitations in the claims are the same. *Id.* (citing *Corbett*, 568 F.2d at 766, 196 USPQ at 343). The analysis focuses on the later-filed claims to determine whether all material limitations therein are necessarily present in the prior claims. *Berger*, 279 F.3d at 982, 61 USPQ2d at 1527. If all material limitations of the later-filed claims are present in, or necessarily result from, the prior claims, then the later-filed claims are entitled to the earlier effective filing date of the prior claims for purposes of satisfying 35 USC § 135(b). *Id.*

According to DeBonte, the claims of the DeBonte '279 Application and the Sernyk '755 Patent are directed to the "same patentable invention" since there is no material distinction

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<sup>9</sup>The original DeBonte '279 Application claims relied on by DeBonte, claims 4, 6, 8, 14 and 17-19 (SX 2018), are reproduced in the attached Appendix. DeBonte also relies on claims 20-31 of the DeBonte '279 Application which were added by an amendment filed January 14, 1998 (SX 2019). These claims recite, *inter alia*, a canola oil having an  $\alpha$ -linolenic content of about 1.7 to about 7% relative to the total fatty acid content.

between claims which recite a canola oil from *Brassica napus* in terms of percentages for oleic, linoleic and  $\alpha$ -linolenic acids (DeBonte '279 Application) and claims which recite a canola oil in terms of a ratio of oleic acid/linolenic acid or (oleic acid + linoleic acid)/linolenic acid (Sernyk '755 Patent). (DeBonte Opposition 1, Paper 39, page 16). DeBonte notes that the DeBonte '279 Application claims recited a canola oil in terms of percentage of  $\alpha$ -linolenic acid and persons of ordinary skill in the art would appreciate that the claimed oils contained oleic, linoleic and  $\alpha$ -linolenic acids, the oleic acid content, though not explicitly recited in the DeBonte '279 Application claims, being as high as 72.6% (*id.*, pp. 16-17).

In support of their position, DeBonte argues that the explicit recitation of oleic acid content in the DeBonte '698 Application claims was not considered material to patentability. The patentable distinction and material limitation upon which the examiner's allowance of the DeBonte '698 Application claims was based is the  $\alpha$ -linolenic acid content of the canola oil, not the oleic acid content (DeBonte Opposition 1, Paper 39, p.1). Sernyk argues that the examiner's use of the phrase *in conjunction with* in the Examiner's Reasons for Allowance<sup>10</sup> suggests that the examiner viewed the *combination* of an  $\alpha$ -linolenic acid content of less than 7% and oleic acid content of 66.3% to 72.6% as a material limitation necessary to patentably distinguish the

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<sup>10</sup>"One of the primary purposes of [a statement of reasons for allowance] is to improve the quality and reliability of issued patents by providing a complete file history which should clearly reflect, as much as is reasonably possible, the reasons why the application was allowed. Such information facilitates evaluation of the scope and strength of a patent by the patentee and the public and may help avoid or simplify litigation of a patent." *Zenith Labs., Inc. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418,1425, n.7, 30 USPQ2d 1285, 1290 n.7 (Fed. Cir. 1994) (citing MPEP § 1302.14).

DeBonte '698 Application claims over U.S. Pat. 5,387,758 (Sernyk Preliminary Motion 1, Paper 24, p. 17).

We find that Sernyk's position is supported by the dictionary definition of the term *conjunction*: "1. The act of conjoining or being conjoined: union; association; combination ." Webster's Third New International Dictionary 480 (1993). Sernyk's position is further supported by the fact that a canola oil containing reduced  $\alpha$ -linolenic acid (i.e., below 8%) was known as early as 1987 (DX 1006, p. 453; SX 2032, col. 1, ll. 50-53). It is unlikely that the examiner would have considered the claim limitation of  $\alpha$ -linolenic acid content alone as sufficient to distinguish over the prior art. We further note the absence of any comments by DeBonte in the '698 Application in response to the Examiner's Reasons for Allowance. Although an applicant is not required to comment on the examiner's reasons for allowance, failure of an applicant to do so "may give rise to a presumption of acquiescence to those reasons, and the negative inferences that flow therefrom." See MPEP § 1302.14. Cf. *Kinzenbaw v. Deere & Co.*, 741 F.2d 383, 222 USPQ 929 (Fed. Cir. 1984), *cert. denied*, 470 U.S. 1004, 105 S.Ct. 1357, (1985)<sup>11</sup>; *Parks v. Fine*, 773 F.2d 1577, 1579, 227 USPQ 432, 434 (Fed. Cir. 1985) (The

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<sup>11</sup> In *Kinzenbaw*, the invention was directed to a rowplanter, for planting seeds. The defendant attempted to avoid the doctrine of prosecution history estoppel on the ground that the patentee's limitation of his claims to devices in which gauge wheels had a smaller radius than the discs was unnecessary to distinguish the prior art. Defendant pointed out that the prior art over which the examiner found the patent unpatentable, also contained a gauge wheel with a smaller radius than that of the discs. Defendant argued that only the portion of the claim limitation that provided that the radius of the gauge wheels must exceed the distance from the axes of the wheels to the rear edges of the discs was necessary to render the claims patentable over the prior art. The court declined to speculate whether the examiner would have allowed the claim if the patentee had added only one of the limitations to his claim.

insertion of a limitation to overcome the examiner's rejection is strong, if not conclusive, evidence of materiality). Thus we are in agreement with Sernyk that the recited oleic acid content was material to allowance of the DeBonte '698 Application claims.

DeBonte asserts that oleic acid content and ratios recited in the DeBonte '698 Application claims, though not recited in the DeBonte '279 Application claims, were nonetheless inherent claim features. Thus, the DeBonte '279 Application claims are directed to "the same or substantially the same" oil as recited in the Sernyk '755 Patent claims.

The DeBonte '279 Application claims relied on by DeBonte (*see* Appendix) include claims directed to "improved vegetable oil extracted from *Brassica napus* seeds . . . having . . . an  $\alpha$ -linolenic acid content of 7% or less relative to total fatty acid content of said seed" (claim 17) and "oil produced from a *Brassica napus* plant designated IMC 01" (claims 5 and 6).

According to DeBonte:

There can be no doubt that the claimed oils necessarily contain oleic acid. Canola oil from *Brassica napus*, by definition, inherently contains oleic acid. The oleic acid content of the DeBonte oils are disclosed in the supporting disclosure. Persons of ordinary skill in the art would fully appreciate that DeBonte's oils contain oleic acid, linoleic acid and linolenic acid; and that the oleic acid content was as high as, for example, 72.6%.

(DeBonte Opposition 1, Paper 39, pp. 16-17). DeBonte points out that the DeBonte '279 Application teaches that canola oil includes these three acids. *Id.*, p. 13. Further, Table I of the DeBonte '279 Application shows that IMC 01, i.e., a canola oil having an  $\alpha$ -linolenic acid content of 7% or less, may contain an oleic acid content of 72.6%, a linoleic acid content of 14.4%. *Id.*

Sernyk maintains that the DeBonte '279 Application<sup>12</sup> does not support DeBonte's position that claims reciting an oil produced from a *Brassica napus* plant designated IMC 01 or an oil having an  $\alpha$ -linolenic acid content of 7% or less inherently include an oleic acid content of 72.6% or any other value which would fall within the scope of the Sernyk '755 patent claims<sup>13</sup> (Sernyk Reply 1, Paper 42, p. 3). Sernyk argues that the 72.6% data point in Table I of the DeBonte '279 Application is "a mere probability or possibility based on the numerical data provided in various sources, the 72.6% value is clearly an aberration when viewed in the context of all other available fatty acid profile data for IMC 01" (Sernyk Reply 1, Paper 42, p. 9). Sernyk points out that of the five fatty acid profiles reported in Table I of the DeBonte '279 specification, only one, 8/88, falls within the scope of the '755 patent claims (Sernyk Reply 1, Paper 42, pp. 5-7, ¶¶ 5-7). Sernyk also relies on the Applications for Plant Variety Protection Certificates for IMC 01 (SX 2002, p. 4) and IMC 130 (SX 2040), the 1995 Keller publication and Table X of DeBonte's '279 specification (SX 2018, p. 28). In each of these documents, IMC 01 is indicated as having less than 65% oleic acid (Sernyk Reply 1, Paper 42, p. 6, ¶ 8). With respect to the DeBonte '279 Application claims relied on by DeBonte as supporting their inherency argument, Sernyk points out that claims 6 and 8 do not recite an oleic or  $\alpha$ -linolenic acid content and claim 4 depends from a claim directed to "a *Brassica napus* plant" (Sernyk Reply 1, Paper 42, p. 4).

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<sup>12</sup>Sernyk also argues that DeBonte is not entitled to rely on the Fan '366 Application because the application names a different inventive entity and is unrelated to the DeBonte '698 Application (Sernyk Preliminary Motion 1, Paper 24, p. 3). DeBonte does not present any opposing arguments.

<sup>13</sup>During the January 16 2004 conference call (*see, supra*, page 10), Sernyk also requested, and was given authorization to file preliminary motions to establish unpatentability under 35 USC § 112, first paragraph, written description and enablement provisions (Paper 16, ¶¶ 9 and 10) and to establish that there is no interference-in-fact (37 CFR § 1.633(b)) on the basis the DeBonte '698 application does not enable and/or lacks written description of any embodiment within the scope of Counts 1 or 2 (Paper 16, ¶ 1).

In an interference, data based on experiments described in a specification of an involved patent or application is not admissible *per se* to establish that the experiments, in fact, were carried out as described, or that data generated as a consequence of the experiments (i.e., a particular result), in fact, was obtained as described.<sup>14</sup> All parties to an interference are given notice of the hearsay nature of statements in a specification in ¶ 14.6 of the Trial Section's Standing Order (Paper 1) which provides that:

A specification of an application or patent involved in the interference is admissible as evidence only to prove what the specification or patent describes.

If there is data in the specification upon which a party intends to rely to prove the truth of the data, an affidavit by an individual having first-hand knowledge of how the data was generated (i.e., the individual who performed an experiment reported as an example in the specification) must be filed.

The individual may be cross-examined.

Further, under ¶ 14.10 of the Standing Order,

[A] party relying on data generated from a scientific test shall explain:

- (a) the reason why the test is being used and why the data is being relied upon;
- (b) how the test is performed;
- (c) how the data is generated using the test;
- (d) how the data is used to determine a value
- (e) the acknowledged accuracy of the test; and
- (f) any other information that would aid the board in understanding the significance of the test or data.

Any explanation should take place through affidavit testimony of a witness.

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<sup>14</sup>In *inter partes* interference proceedings, the Federal Rules of Evidence apply (37 CFR § 1.671(b)), and those rules authorize the Board to exercise its discretion to sustain an objection to the admissibility of evidence based on hearsay (Fed. R. Evid. 802).

(See Sernyk Reply 1, Paper 42, p. 2)<sup>15</sup>. Having failed to submit an affidavit, DeBonte is not entitled to rely on Table I as proof that *Brassica napus* necessarily contains 72.6% oleic acid. See, *Knorr v. Pearson*, 671 F.2d 1368, 1373, 213 USPQ 196, 200 (CCPA 1982) (attorney argument cannot take the place of evidence lacking in the record). See also, *Meitzner v. Mindick*, 549 F.2d 775, 782, 193 USPQ 17, 22 (CCPA), *cert. denied*, 434 U.S. 854, 195 USPQ 465 (1977); *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); *Wojciak v. Nishiyama*, 61 USPQ2d 1576, 1580 (Bd. Pat. App. & Int. 2001) (data in the specification to prove results of experiment is inadmissible hearsay).

Sernyk is also not entitled to rely on the Plant Variety Protection Certificates for IMC 01 and 130, the Keller 1995 publication and the DeBonte '279 specification as proof of the data contained therein (*see, supra*, Standing Order, p. 16). However, the absence of any explicit description in these documents of a fatty acid profile for IMC 01 having oleic, linoleic and  $\alpha$ -linolenic acid contents which meet the limitations of the Sernyk '755 patent claims clearly undermines DeBonte's position that IMC 01 inherently includes up to 72.6% oleic acid.

Proof of inherency requires evidence that the "necessary and only reasonable construction to be given the disclosure by one skilled in the art is one which will lend clear support to each positive limitation." *Kennecott Corp. v. Kyocera International Inc.*, 835 F.2d 1419, 1423, 5 USPQ2d 1194, 1198 (Fed. Cir. 1987) (quoting *Langer v. Kaufman*, 465 F.2d 915, 918, 175

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<sup>15</sup>The time has not yet come for filing motions to suppress (37 CFR § 1.635). However, Sernyk has, in effect, objected to the admissibility of Table I as proof of the acid content of *Brassica napus*/IMC 01. This objection is sustained.



USPQ 172, 174 (CCPA 1972) (quoting *Binstead v. Littmann*, 242 F.2d 766, 770, 113 USPQ 279, 282 (CCPA 1957))). As noted by the CCPA:

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

*In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting *Hansgird v.*

*Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)). It is not sufficient that a person following the patent disclosure might obtain the result set forth, it must inevitably happen.

*Dreyfus v. Sternau*, 357 F.2d 411, 415, 149 USPQ 63, 66 (CCPA 1966); *Crome v. Morrogh*, 239 F.2d 390, 392, 112 USPQ 49, 50 (CCPA 1956).

Even if DeBonte were to submit an affidavit to prove the truth of the data in the DeBonte '279 Application in accordance with the Standing Order (*see, supra*, p. 16), DeBonte would be hard-pressed to establish that the "necessary and only reasonable construction" to be given to the DeBonte '279 Application claims is that they are directed to a canola oil or oil from the seed of *Brassica napus* containing oleic, linoleic and  $\alpha$ -linolenic acid contents which fall within the scope of the Sernyk '755 Patent claims (*see* Sernyk Reply 1, Paper 42, pp. 5-7). Although Table I includes an oil having a fatty acid profile which falls within the scope of the Sernyk '755 Patent claims, the Federal Circuit has clearly stated that it is improper to read into the claims an extraneous limitation from the specification. *E. I. du Pont de Nemours & Co. v. Phillips*

*Petroleum Co.*, 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir. 1988). While the specification is useful in interpreting claim language, "the name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). In *Du Pont*, 849 F.2d at 1433, 7 USPQ2d at 1131, the Federal Circuit stated:

It is entirely proper to use the specification to interpret what the Patentee meant by a word or phrase in the claim. *See, e.g., Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 867, 228 USPQ 90, 93 (Fed. Cir. 1985). But this is not to be confused with adding an extraneous limitation appearing in the specification, which is improper. By "extraneous," we mean a limitation read into a claim from the specification wholly apart from any need to interpret what the patentee meant by particular words or phrases in the claim.

"The question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, a prior application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought." *Lockwood v. American Airlines*, 107 F.3d 1565, 1571-72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). *See also, In re Blaser*, 556 F.2d 534, 538, 194 USPQ 122, 125 (CCPA 1977) ("However, the flaw in this argument is that enablement and obviousness are not the issues; description of the invention is."); *In re Winkhaus*, 527 F.2d 637, 640, 188 USPQ 129, 131 (CCPA 1975) ("That a person skilled in the art might realize from reading the disclosure that such a step is possible is not a sufficient indication to that person that the step is part of appellants' invention"); *In re Ruschig*, 379 F.2d 990, 995, 154 USPQ 118, 123 (CCPA 1967) ("While we have no doubt a person so motivated would be enabled by the specification to make it, this is beside the point for the question is not whether he would be so

enabled but whether the specification discloses the compound to him, specifically, as something appellants actually invented."). The specification must provide descriptive support for the full scope of the claimed subject matter. *Conservolite Inc. v. Widmayer*, 21 F.3d 1098, 1100, 30 USPQ2d 1626, 1628 (CAFC 1994). An applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566, 43 USPQ2d 1398, 1404 (Fed. Cir. 1997) (quoting *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966).

The DeBonte '279 Application focuses on the  $\alpha$ -linolenic content and sulfur content of IMC 01. Any disclosure relating to oleic and linoleic content of IMC 01 is limited to the data presented in Table I. Although DeBonte alleges that one of ordinary skill in the art would fully appreciate that the DeBonte '279 Application claims were directed to oils having the oleic acid, linoleic acid and  $\alpha$ -linolenic acid contents necessary to satisfy the ratios specified in the Sernyk '755 patent claims, DeBonte has failed to identify any description in the DeBonte '279 Application which would direct one of ordinary skill in the art to select these particular oils. Moreover, DeBonte has failed to submit meaningful evidence in the form of declaration or affidavit testimony to establish that one with ordinary skill in the art would have known that the invention claimed in the DeBonte '279 Application was directed to those oils which fall within the scope of the Sernyk '755 Patent claims.

The evidence fails to show that the DeBonte '279 Application claims inherently included the ratios specified in the Sernyk '755 patent claims. Accordingly, we find that DeBonte did not present claims for the same or substantially the same subject matter as the Sernyk '755 patent prior to one year from the date on which the Sernyk '755 patent was granted


#### IV. ORDER

Upon consideration of the record, and for the reasons given, it is:


**ORDERED** that Sernyk Preliminary Motion 1 is *granted*.

**FURTHER ORDERED** that DeBonte file its preliminary motion under 37 CFR §1.633(i)<sup>16</sup> within two weeks of the date of this Order.

**FURTHER ORDERED** that Sernyk file any opposition within one week of the filing date of DeBonte's preliminary motion under 37 CFR §1.633(i) .

  
RICHARD E. SCHAFER  
Administrative Patent Judge

  
RICHARD TORCZON  
Administrative Patent Judge

  
LINDA R. POTEATE  
Administrative Patent Judge

) BOARD OF PATENT  
) APPEALS AND  
) INTERFERENCES  
) INTERFERENCE  
) TRIAL SECTION

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<sup>16</sup>DeBonte has indicated that they intend to file a preliminary motion under 37 CFR §1.633(i) (See Paper 47).

cc (via Facsimile and Federal Express):

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## APPENDIX

4. The oil of the seed produced by the plant of Claim 1<sup>17</sup>.
5. A *Brassica napus* plant designated IMC 01 represented by seed deposited with the ATCC and bearing accession number 40579.
6. The oil produced from the variety of Claim 5.
8. A *Brassica napus* comprising oil, which when non-hydrogenated, is significantly reduced in fishy odor intensity relative to the fishy odor intensity of generic canola oil, a significant difference in fishy odor intensity indicated by a difference of greater than 1.0 obtained in standardized sensory evaluation.
14. The oil extracted from the seed produced by the process of Claim 13<sup>18</sup>.
17. An improved vegetable oil extracted from *Brassica napus* seeds, said seeds having:
  - (1) an oil which exhibits following crushing and extraction

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<sup>17</sup>Claim 1 reads:

A *Brassica napus* plant com[p]rising

seed having a total glucosinolates content of about 18  $\mu\text{mol/g}$  or less of defatted, air-dried meal;

the seed yielding oil having an  $\alpha$ -linolenic acid content of 7% or less relative to total fatty acid content of said seed and a sulfur content of less than or equal to 3.0 ppm; and

the plant belonging to a line in which these traits have been stabilized for both the generation to which the seed belongs and that of its parent generation.

<sup>18</sup> Claim 13 reads:

A process for producing a canola of enhanced commercial utility comprising:

(A) crossing the *Brassica napus* IMC 01 with an agronomically elite variety;

(B) selecting the off-spring of step (a) which yield a seed having a total glucosinolates content of about 18  $\mu\text{mol/g}$  or less of defatted, air-dried meal, said seed yielding extractable oil having (1) an  $\alpha$ -linolenic acid content of about 7% or less relative to total fatty acid content of said seed, and (2) a sulfur content of less than or equal to 3.0 ppm.

- (a) an  $\alpha$ -linolenic acid content of 7% or less relative to total fatty acid content of said seed;
  - (b) a sulfur content of less than or equal to 3.0 ppm; and
- (2) a total glucosinolates content of about 18  $\mu\text{mol/g}$  or less of defatted, air-dried meal.

18. The oil produced from the progeny of Claim 1, 5 or 9, as described in Claim 10, wherein the stability of such oil measured in AOM hours is from about 25.0 to about 35.0

19. The oil as described by Claim 18 wherein the stability in AOM hours is from 26.8 to 31.5.